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EXAMINER

ROSEN, NICHOLAS D

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3625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/528,528	Applicant(s) AHN, HEE-JUNG	
	Examiner Nicholas D. Rosen	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-23 have been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4

Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (U.S. Patent 6,370,514) in view of Melero et al. (U.S. Patent Application Publication 2002/0111879). As per claim 1, Messner discloses a gift certificate service system for managing sales, gifting, and usage of electronic gift certificates according to a request by a user's communication terminal through a network, comprising: a gift certificate service server for managing purchase, gifting, and usage operations on the electronic gift certificates from the communication terminal (Abstract; column 3, lines 4-20); and a gift certificate database, accessed by the gift certificate service server, for storing electronic gift certificate information, and processing a reply to an inquiry of electronic gift certificate usage from the gift certificate service server (ibid.; column 1, lines 19-33). Messner does not expressly disclose a distinct network server, accessed by the gift certificate server and accessing the user's communication terminal, but does disclose a voucher server which users' communication terminal access, and which

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accesses other servers, including merchants' gift certificate servers (Figure 3; column 5, lines 31-40; column 7, lines 18-43). Messner does not expressly disclose this voucher server/network server performing a client interface function with the purchase, gifting, and usage of the electronic gift certificates, and transmitting the user's gift certificate purchase particulars and gift certificate information for usage of the corresponding gift certificate to the communication terminal, but does disclose a personal computer or other communication terminal of the user (column 5, lines 31-40; column 7, lines 17-27; Figure 3), and it is well known to transmit information on purchase particulars to users' personal computers or other communication terminals to perform client interface functions, as taught, for example, by Melero (paragraphs 54 and 59). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for a network server to perform such a client interface function, for such obvious advantages as confirming to the user what gift certificate(s) he had purchased, on what terms.

As per claim 4, Messner discloses means for receiving a request for usage from a user of the system via a communications terminal (column 7, lines 18-43; column 9, line 66, through column 10, line 20); means for inquiring the gift certificate database of an existence state of the gift certificate possessed by the user (column 10, lines 21-37); means for settling the price with the gift certificate and determining whether the settlement is possible (column 10, lines 28-57); means for processing the settlement on the price information when a settlement is possible (column 10, lines 28-57), updating the settlement information, and storing the updated information in the gift certificate

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database (column 10, lines 28-57, especially lines 38-43); and means for notifying the user of the gift certificate usage information in a message format (column 10, lines 28-57, especially lines 38-43).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messner and Melero as applied to claim 1 above, and further in view of Lindquist (U.S. Patent Application Publication 2003/0018553). Messner discloses means for receiving a user's purchase request from the communication terminal (column 7, line 45, through column 8, line 58); means for settling the electronic gift certificate bought by the user, and issuing the bought electronic gift certificate to the user, when the user requests settlement (column 8, line 59, through column 9, line 17); and Messner discloses that issued gift certificate information is stored in a gift certificate database (column 9, line 66, through column 10, line 37), requiring means for storing it. Messner does not expressly disclose means for notifying the user of the gift certificate purchase particulars in a message format (although Messner does disclose notifying the user of the delivery or non-delivery of the gift certificate to a recipient, column 9, lines 51-65), but it is well known to notify users of purchase particulars, as taught, for example, by Melero (paragraphs 54 and 59). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have means for notifying the user of the gift certificate purchase particulars in a message format, for such obvious advantages as confirming to the user what gift certificate(s) he had purchased, on what terms.

Messner does not expressly disclose means for checking a settlement state of the electronic gift certificate bought by the user, but Lindquist teaches checking a settlement state of an electronic gift certificate bought by a user (paragraph 46). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to include means for checking a settlement state of the electronic gift certificate bought by the user, for at least the obvious advantages of assuring that the price of the gift certificate would be paid once and only once, and that payment or authorization was valid.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messner and Melero as applied to claim 1 above, and further in view of Cheong (U.S. Patent 7,006,993). Messner discloses means for receiving a user's gifting request from the communication terminal; means for receiving information on the gift certificate to be gifted and a transferee; and means for transmitting the gift certificate selected by the user to the transferee (column 5, lines 31-40; column 8, lines 36-58; column 9, lines 1-17); and means for notifying the user of the gift certificate gifting information in a message format (column 1, lines 51-65). Messner does not expressly disclose means for inquiring an existence state of the gift certificate possessed by the user of the gift certificate database, and determining the existence state, but Cheong teaches this (column 11, lines 54-67). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to inquire and determine the existence state of the certificate, for the obvious advantage of not losing

money and/or creating ill will and legal liability by transferring nonexistent or invalid gift certificates.

Based on Applicant's statement (page 13 of the Remarks filed march 3, 2008), claims 2, 3, and 4, which use "means for" language, are now treated as invoking 35 U.S.C. 112, sixth paragraph.

Claims 5-9

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (U.S. Patent 6,370,514) in view of Melero et al. (U.S. Patent Application Publication 2002/0111879) and Lindquist (U.S. Patent Application Publication 2003/0018553).

Messner discloses an electronic gift certificate circulating method, comprising: (a) receiving a user's purchase request from the communication terminal (column 7, line 45, through column 8, line 58); (c) settling the electronic gift certificate, and issuing the electronic gift certificate to the user, when the user requests settlement (column 8, line 59, through column 9, line 17); and (d) storing issued gift certificate information in a gift certificate database (column 9, line 66, through column 10, line 37). Messner does not expressly disclose (e) notifying the user of the gift certificate purchase particulars and gift certificate information for usage in a message format (although Messner does disclose notifying the user of the delivery or non-delivery of the gift certificate to a recipient, as well as notifying a recipient of a gift certificate [column 9, lines 51-65]), but it is well known to notify users of purchase particulars, as taught, for example, by Melero (paragraphs 54 and 59). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to notify the user of

the gift certificate purchase particulars and gift certificate information for usage in a message format, such obvious advantages as confirming to the user what gift certificate(s) he had purchased, on what terms.

Messner does not expressly disclose (b) checking a settlement state of the electronic gift certificate bought by the user, but Lindquist teaches checking a settlement state of an electronic gift certificate bought by a user (paragraph 46). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to check a settlement state of the electronic gift certificate bought by the user, for at least the obvious advantages of assuring that the price of the gift certificate would be paid once and only once, and that payment or authorization was valid.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messner, Melero, and Lindquist as applied to claim 5 above, and further in view of Ganesan et al. (U.S. Patent Application Publication 2002/0087469). Messner does not disclose checking the user's membership authentication state, but Ganesan discloses that a user must be registered as a member to make payments to, or receive payments from, other members (paragraph 107), and that membership is verified for recipients of electronic gift certificates in particular (paragraphs 208-209). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to check the user's membership authentication state, for at least the obvious advantages of greater security in transactions, and being able to identify users in the case of errors or possibly fraudulent or otherwise unlawful transactions.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messner, Melero and Lindquist as applied to claim 5 above, and further in view of Whitfield (U.S. Patent 7,209,889), and Lee (U.S. Patent 2002/0032605). Messner does not explicitly disclose that the purchase request includes information on a category of the gift certificates desired by the user and a price (although the “category” limitation may arguably be met by Messner), but it is well known for a purchase request to include information on a price of a gift certificate, as taught by Whitfield (column 14, lines 17-20). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant’s invention for the purchase request to include information on a price, for the obvious advantage of the user choosing a gift neither embarrassingly small nor unaffordably large.

Lee discloses a purchase request for an electronic gift certificate including a category (e.g., paragraphs 41, 42, and 54). (Note that Messner, column 7, lines 51-65, may be read as disclosing such a category, as well.) Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant’s invention for the purchase request to include information on a category, for at least the stated advantage of the user demonstrating that he made an effort to tailor the gift to a recipient’s taste.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messner, Melero, and Lindquist as applied to claim 5 above, and further in view of official notice. Messner does not disclose that the settlement price of the gift certificate is summed with the user’s communication terminal usage fee, and the summed price and fee are then

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settled, but official notice is taken that it is well known for shopping to be conducted with communication terminals, the prices paid being summed with the user's communication terminal usage fee (e.g., put on a mobile phone bill, or even an ISP's charges), and then settled (e.g., when the user pays his mobile phone fee). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the settlement price of the gift certificate to be summed with the user's communication terminal usage fee, and the summed price and fee then to be settled, for the obvious advantage of conveniently arranging payment through use of a communication terminal, and enabling the seller of the gift certificate to be relatively confident of receiving payment.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messner, Melero, and Lindquist as applied to claim 5 above, and further in view of Aho et al. (U.S. Patent Application Publication 2001/0039589). Messner does not disclose that the message format includes SMS (short message service) or MMS (multimedia message service), but SMS and MMS are both well known, as taught, for example, by Aho (paragraph 6). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the message format to include one or both of SMS and MMS, for the obvious advantage of conveniently making the message available to the user.

Claims 10-14

Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (U.S. Patent 6,370,514) in view of Cheong (U.S. Patent 7,006,993) and

Melero et al. (U.S. Patent Application Publication 2002/0111879). As per claim 10, Messner discloses an electronic gift certificate circulating method, comprising: (a) receiving a user's gifting request from a communication terminal (column 7, line 45, through column 8, line 58); receiving information on the gift certificate to be gifted and a transferee when the user's gift certificate, or a gift certificate purchasable by the user, is found (column 7, line 51, through column 8, line 68); and (d) transmitting the gift certificate selected by the user to the transferee (column 8, lines 36-58; column 9, lines 51-65); and Messner implies (e) updating the user's gift certificate information (e.g., by informing the user of the delivery or non-delivery of the gift certificate, column 9, lines 51-65) and storing updated information in a gift certificate database together with the transferee's gift certificate information (column 10, lines 21-57).

Messner does not expressly disclose (b) inquiring an existence state of the gift certificate possessed by the user of the gift certificate database, and determining the existence state, but Cheong discloses inquiring and determining the existence state of a gift certificate possessed by the user of the gift certificate database (column 11, lines 54-67). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to inquire and determine the existence state of the certificate, for the obvious advantage of not losing money and/or creating ill will and legal liability by transferring nonexistent or invalid gift certificates.

Messner does not expressly disclose (f) notifying the user of the gift certificate gifting information in a message format (although Messner does disclose notifying the user of the delivery or non-delivery of the gift certificate to a recipient, column 9, lines

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51-65), but it is well known to notify users of relevant information on purchases, as taught, for example, by Melero (paragraphs 54 and 59). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to notify the user of the gift certificate gifting information in a message format, for such obvious advantages as confirming to the user what gift certificate(s) he had purchased, on what terms, and to whom the certificate(s) had been sent.

As per claim 12, Messner discloses determining whether an additional gift to be transmitted together with the gift certificate is provided, and receiving corresponding information when the additional gift is found according to the determination, and transmitting the gift certificate and the additional gift to the transferee (column 9, lines 9-17 and 22-27).

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messner, Cheong, and Melero as applied to claim 10 above, and further in view of Ganesan et al. (U.S. Patent Application Publication 2002/0087469). Messner discloses performing a gift certificate buying process when the user presumably has no gift certificate (Abstract; column 7, line 45, through column 8, line 68). Messner does not disclose checking the user's membership authentication state between (a) and (b), but Ganesan discloses that a user must be registered as a member to make payments to, or receive payments from, other members (paragraph 107), and that membership is verified for recipients of electronic gift certificates in particular (paragraphs 208-209). Hence, it would have been obvious to one of ordinary skill in the art of electronic

commerce at the time of applicant's invention to check the user's membership authentication state between (a) and (b), for at least the obvious advantages of greater security in transactions, and being able to identify users in the case of errors or possibly fraudulent or otherwise unlawful transactions.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messner, Cheong, and Melero as applied to claim 10 above, and further in view of official notice. Messner discloses a theme card (column 9, lines 9-17 and 22-27). Messner does not disclose that the additional gift includes a bell sound, background music, and a character, but official notice is taken that it is well known for virtual cards to include characters, and sound, which may include background music, and a bell sound if desired. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the additional gift include a bell sound, background music, and a character, for the obvious advantage of making the virtual gift card a more complete, appealing, and memorable experience.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messner, Cheong, and Melero as applied to claim 10 above, and further in view of Aho et al. (U.S. Patent Application Publication 2001/0039589). Messner does not disclose that the message format includes SMS (short message service) and MMS (multimedia message service), but SMS and MMS are both well known, as taught, for example, by Aho (paragraph 6). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the message format to

include one or both of SMS and MMS, for the obvious advantage of conveniently making the message available to the user.

Claims 15-23

Claims 15, 18, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (U.S. Patent 6,370,514) in view of official notice. As per claim 15, Messner discloses an electronic gift certificate circulating method, comprising: (a) receiving a request for usage from a user of the system via a communications terminal (column 7, lines 18-43; column 9, line 66, through column 10, line 20); (b) inquiring the gift certificate database of an existence state of the gift certificate possessed by the user (column 10, lines 21-37); (c) settling the price with the gift certificate and determining whether the settlement is possible (column 10, lines 28-57); (d) processing the settlement on the price information when a settlement is possible (column 10, lines 28-57), (e) updating the settlement information, and storing the updated information in the gift certificate database (column 10, lines 28-57, especially lines 38-43); and (f) notifying the user of the gift certificate usage information in a message format (column 10, lines 28-57, especially lines 38-43). Messner does not expressly disclose that the usage request is selected by the user from among the gift certificate information stored in the communication terminal, but does disclose delivering messages regarding a gift certificate to a recipient, by email or other means (column 9, lines 51-65). Official notice is taken that it is well known to store received emails in the communication terminals of recipients, which would result in gift certificate information being stored in the communication terminal. Hence, it would have been obvious to one

of ordinary skill in the art of electronic commerce at the time of applicant's invention for the usage request to be selected by the user from among the gift certificate information stored in the communication terminal, as an obvious consequence of the use of emails.

As per claim 18, Messner does not expressly disclose that the usage request is transmitted from the user's mobile communications terminal, although Messner does disclose the use of personal digital assistants, which are mobile (column 5, lines 31-40), but official notice is taken that mobile communication terminals are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the usage request to be transmitted from the user's mobile communications terminal, for the obvious advantage of enabling the user to conveniently use a gift certificate with equipment which he is likely to have, even if away from his home, or even if he does not own a relatively immobile home computer.

As per claim 23, Messner discloses that the recipient who is using an electronic gift certificate may request usage by a usage request transmitted from an online shop which may be an online shopping mall, where the user buys a desired product and requires an online settlement (column 9, line 66, through column 10, line 53).

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (U.S. Patent 6,370,514) and official notice as applied to claim 15 above, and further in view of Ganesan et al. (U.S. Patent Application Publication 2002/0087469) and the anonymous article, "Ecount Introduces Incentives Program," hereinafter "Ecount." Messner does not disclose checking the user's membership authentication state between (a) and (b), but Ganesan discloses that a user must be registered as a

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member to make payments to, or receive payments from, other members (paragraph 107), and that membership is verified for recipients of electronic gift certificates in particular (paragraphs 208-209). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to check the user's membership authentication state between (a) and (b), for at least the obvious advantages of greater security in transactions, and being able to identify users in the case of errors or possibly fraudulent or otherwise unlawful transactions.

Messner does not disclose performing a gift certificate buying process when the user has no gift certificate in (b) (although Messner of course discloses a gift certificate buying process, e.g., Abstract; column 7, line 45, through column 8, line 68), but "Ecount" teaches users paying into their own ecount accounts, either to be routed to other users, or for them to spend (whole article, especially paragraph beginning, "In use, ecount allows"); such paying may be viewed as buying a gift certificate. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to perform a gift certificate buying process when the user has no gift certificate in (b), for the obvious advantage of having money to spend on desired purchases, as in "Ecount."

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messner and official notice as applied to claim 15 above, and further in view of Aho et al. (U.S. Patent Application Publication 2001/0039589). Messner does not disclose that the message format includes SMS (short message service) or MMS (multimedia message service), but SMS and MMS are both well known, as taught by Aho (paragraph 6).

Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the message format to include one of SMS and MMS, for the obvious advantage of conveniently making the message available to the user.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (U.S. Patent 6,370,514) and official notice as applied to claim 18 above, and further in view of Kasasaku (U.S. Patent Application Publication 2003/0004812). Messner does not disclose that the mobile communication terminal has a credit card function therein, but it is well known for mobile communication terminal to have credit card functions therein, as taught by Kasasaku (paragraph 15). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the mobile communication terminal has a credit card function therein, for the stated advantage of enabling settlement processing to be implemented within a sales outlet, and for the obvious advantage of making credit card or credit card-like payments via a mobile phone or similar device, perhaps remotely.

Claims 20, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (U.S. Patent 6,370,514) and official notice as applied to claim 18 above, and further in view of Whitfield (U.S. Patent 7,209,889). As per claim 20, Messner does not disclose that the usage request is transmitted from a chain store's card terminal according to a card usage by the user, but Whitfield teaches an electronic gift certificate being transferred to the user as data to be placed on a smart card (column 14, lines 24-35; column 14, line 64, through column 15, line 3), and official

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notice is taken that it is well known to use cards at chain stores' card terminals to demonstrate that one qualifies for a discount or benefit, or is spending stored value (as with a gift card). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the usage request is transmitted from a chain store's card terminal according to a card usage by the user, for the obvious advantage of making use of an electronic gift certificate stored on a card, as taught by Whitfield; it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to store an electronic gift certificate on a card, for such obvious advantages as being able to conveniently present the electronic gift certificate when shopping in a brick-and-mortar store.

As per claim 21, neither Messner nor Whitfield discloses that the user's card is a membership card for membership authentication by service providers including a communication service provider and a distribution company, but official notice is taken that it is well known for cards to be membership cards usable for membership identification by a variety of businesses. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the user's card to be a membership card for membership authentication by service providers including a communication service provider and a distribution company, for the obvious advantage of making electronic gift certificates usable with known cards in widespread possession.

As per claim 22, neither Messner nor Whitfield discloses that the user's card is a brand card, but official notice is taken that brand cards are well known (for example,

Examiner has been carrying brand cards qualifying him for discounts at supermarkets since well before 2000). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the user's card to be a brand card, for the obvious advantage of making electronic gift certificates usable with cards in very widespread possession.

Response to Arguments

Applicant's arguments filed March 3, 2008 have been fully considered but they are not persuasive. Applicant has amended to overcome various objections and rejections under 35 U.S.C. 112, but has not established non-obviousness under 35 U.S.C. 103. Applicant argues that the Messner '514 patent fails to teach or suggest a gift certificate database as recited in independent claim 1, while admitting that Messner does disclose a database (column 1, lines 19-33). Examiner replies that the database recited in claim 1, "for storing electronic gift certificate information, and processing a reply to an inquiry of electronic gift certificate usage from the gift certificate service center," is apparently much the same as the database disclosed in Messner. It may be possible to draw distinctions based on what data the databases do and do not hold, but, first, such distinctions could form a basis for patentability only if actual claim limitations set forth the distinctions, and secondly, even if the claims were amended to define the database more narrowly, there would still be questions of possible secondary references, and of variations in the relations of servers to databases.

In response to Applicant's traversal of official notice, Examiner has relied upon Melero as a secondary reference in rejecting claim 1. Examiner has also used Melero and Cheong, in place of official notice, in rejecting claim 10, again in response to Applicant's traversal, and further applied Lindquist (which was made of record in the previous Office Action) in rejecting claims 2 and 5. If Applicant's arguments that the prior Office Action relied upon improper hindsight rest solely on the use of official notice for such points as the well-known character of notifying users of purchase particulars, this use of explicit references should put the matter to rest.

If, however, Applicant takes the view that Examiner's conclusion of obviousness is based upon improper hindsight reasoning even when all claim elements are found in the prior art of record, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The more recent decision, *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007), is also recommended to Applicant's attention.

Examiner has also relied upon an actual prior art reference (Aho) to establish that the SMS and MMS formats are well known. Applicant argues that sending a message in a message format that includes SMS or MMS formats was not necessarily well known at the time of Applicant's invention. Examiner replies that even if this is

correct, it fails to establish non-obviousness. Messner discloses sending notifications to users, and Melero further teaches notifying users of purchase particulars. Some message format or formats would necessarily have to be employed, and SMS and MMS are well known message formats which could have been used to achieve the result of sending notification to users. As the Supreme Court noted in the *KSR* decision, “[I]f there is design need or market pressure to solve [a] problem, and there are [a] finite number of identified, predictable solutions, [a] person of ordinary skill in art has good reason to pursue known options within his or her technical grasp, and if this leads to anticipated success, it is likely product of ordinary skill and common sense, not innovation.” Based on this standard, there does not appear to be any reason to regard the use of well-known message formats to send particular messages to be a patentable innovation, rather than the product of ordinary skill and common sense.

Similarly, to the extent other particular features may not have been well-known in the context of an electronic gift certificate, Examiner maintains that it would have been obvious to one of ordinary skill to apply features and procedures which were well known in general to the particular situation of an electronic gift certificate. To quote further from *KSR* (at 1386), “[R]igid application of preventative rules that deny fact finders recourse to common sense are neither necessary nor consistent with precedent.” Additionally, there is the precedent of See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). It has been held that a prior art reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as

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a basis for rejection of the claimed invention. It is held in the present case that prior art in the field of electronic commerce in general can be viewed as in the field of Applicant's endeavor, and in particular, that teachings reasonably pertinent to the particular problem with which Applicant was concerned may properly be applied, even if they were not in the field of business methods (and be it noted that most of the prior art applied is definitely within the field of business methods or electronic commerce).

Examiner has also relied upon actual prior art (Cheong) to support the known character of inquiring and determining the existence state of a gift certificate; this relates to gift certificates, and not only to files in general.

The Manual of Patent Examination Procedure (2144.03 (C)) states, in regard to traversal of Official Notice:

C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding with Adequate Evidence.

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that

the claims define a patentable invention without reference to the examiner's assertion of official notice would be inadequate.

It may be questioned whether Applicant has met this standard for adequacy of traversal; nevertheless, Examiner has relied on explicit prior art to support those takings of official notice traversed by Applicant.

The common knowledge or well-known in the art statements in the previous office action which were not expressly traversed are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ling (U.S. Patent 7,328,189) discloses a method and apparatus for conducting electronic transactions using electronic tokens. Sosa et al. (U.S. Patent Application Publication 2002/0095387) disclose an online content portal system.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith, can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas D. Rosen/
Primary Examiner, Art Unit 3625
April 16, 2008